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Response
8/26/03

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re Patent Application of
Toshimitsu KONUMA et al.
Serial No. 08/698,204
Filed: August 14, 1996
For: ELECTRO-OPTICAL DEVICE

) Art Unit: 2871
) Examiner: K. Parker

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RESPONSE

Commissioner for Patents
P.O. Box 1450
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Sir:

The Official Action mailed March 6, 2003 has been received and its contents carefully noted. Filed concurrently herewith is a *Request for One Month Extension of Time*, which extends the shortened statutory period for response to July 6, 2003. Accordingly, Applicant respectfully submits that this response is being timely filed.

Applicant notes with appreciation the consideration of the Information Disclosure Statements filed on July 10, 1997; October 3, 1997; June 4, 1999; February 10, 2000; April 17, 2000; May 16, 2000; June 16, 2000; and August 20, 2001. A further Information Disclosure Statement is submitted herewith and careful review and consideration of this Information Disclosure Statement is requested.

Claims 13-15, 21, 24-29, 35-40, 42, 45, 47-49, and 56-70 are now pending in the present application, of which claims 25, 35, 40, 42, 56, 61, and 66 are independent. Claims 47-49 are withdrawn from consideration in the Official Action mailed December 15, 1999. Initially, it is noted that the list of pending claims (box 4) on the *Official Action Summary* appear to omit claim 42. However, based on the inclusion of this claim in the body of the Official Action, it is understood to be pending and considered. Furthermore, the *Official Action Summary* (box 6) appears to indicate several canceled claims as rejected. It is believed that claims 18-20, 22, 30-34, 41, and 46 have previously been canceled and thus should not be listed. Again, the body of the Official Action appears to

correctly reflect the pending claims. Finally, Applicant notes with appreciation the allowance of claims 56-60. For the reasons set forth in detail below, all claims are believed to be in condition for allowance.

Paragraph 1 of the Official Action rejects claims 25-29, 35-39, 47-49, and 61-65 as obvious based on the combination of U.S. Patent 5,200,847 to Mawatari et al. and U.S. Patent 5,278,682 to Niki. As previously noted, MPEP § 2143-2143.01 states that to establish a *prima facie* case of obviousness, three basic criteria must be met. First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings. Second, there must be a reasonable expectation of success. Finally, the prior art reference (or references when combined) must teach or suggest all the claim limitations. Obviousness can only be established by combining or modifying the teachings of the prior art to produce the claimed invention where there is some teaching, suggestion, or motivation to do so found either explicitly or implicitly in the references themselves or in the knowledge generally available to one of ordinary skill in the art. "The test for an implicit showing is what the combined teachings, knowledge of one of ordinary skill in the art, and the nature of the problem to be solved as a whole would have suggested to those of ordinary skill in the art." *In re Kotzab*, 217 F.3d 1365, 1370, 55 USPQ2d 1313, 1317 (Fed. Cir. 2000). See also *In re Fine*, 837 F.2d 1071, 5 USPQ2d 1596 (Fed. Cir. 1988); *In re Jones*, 958 F.2d 347, 21 USPQ2d 1941 (Fed. Cir. 1992).

Independent claims 25, 35, 40, 42, 61, and 66 each recite that a sealing member is provided between the first substrate and the second substrate for sealing a liquid crystal therebetween, that the sealing member encloses a driver circuit, that an inlet for injecting the liquid crystal is provided to the sealing member, and that the inlet is provided on a side where no driver circuit is disposed. The present invention is particularly advantageous in that damage to the driver circuit due to pollution of the liquid crystal can be prevented.

Applicant respectfully submits that Mawatari fails to teach that the sealing member encloses the driver circuit as recited in the claimed invention. Therefore, the claimed invention cannot be obtained even when Mawatari and Niki are combined.

Mawatari clearly shows in Figure 4 sealing member 103 (column 5, line 63) and driver elements 118 and 119 (column 6, lines 32-36). As seen in Figure 4, it is respectfully submitted that sealing member 103 cannot be fairly construed to enclose driver elements 118 and 119. It is respectfully submitted that Mawatari does not disclose or suggest a driver circuit enclosed by a sealing member as recited in the pending claims and that Niki does nothing to overcome this deficiency.

It is respectfully submitted that the Official Action has failed to carry the burden of establishing a *prima facie* case of obviousness. While the Official Action relies on various teachings of the cited prior art to disclose aspects of the claimed invention and asserts that these aspects could be used together, it is submitted that the Official Action does not adequately set forth why one of skill in the art would combine the references to achieve the present invention. The Official Action states that Mawatari may optionally completely enclose the circuits, but provides no basis for this assertion or any clear explanation as to which circuits are alleged to correspond to the claimed driver circuit. MPEP § 2142 further states: "The initial burden is on the examiner to provide some suggestion of the desirability of doing what the inventor has done. 'To support the conclusion that the claimed invention is directed to obvious subject matter, either the references must expressly or impliedly suggest the claimed invention or the examiner must present a convincing line of reasoning as to why the artisan would have found the claimed invention to have been obvious in light of the teachings of the references.' *Ex parte Clapp*, 227 USPQ 972, 973 (Bd. Pat. App. & Inter. 1985)."

Also submitted herewith is a partial English translation of a seminar textbook entitled *Super High Definition Technique in LCD*, authored by Mitsuru Ikezaki, pages 1-6, published July 3, 2001. It is noted that this publication date is after the filing date of the subject application and thus this document is not available as prior art against the subject application.


This article describes that a reliability problem can be caused due to pollution of liquid crystal material if the mounting areas touch the liquid crystal. Further, this article describes that the inlet port for injecting liquid crystal should be provided on a side having no mounting area. As invited in the last paragraph of page 7 of the Official Action, it is respectfully submitted that this article establishes a sufficient factual basis to

conclude that the subject application achieves unexpected results and is particularly advantageous. That is, any *prima facie* case of obviousness is respectfully submitted to be rebutted by this evidence. Reconsideration is requested.

Paragraph 2 of the Official Action rejects claims 13-15, 21, 24-29, 35-40, 42, 45, 47-49, and 66-70 as obvious based on the combination of JP 1-49022 to Matsuo and Niki. As previously asserted, Matsuo fails to provide an inlet port to the sealing member. Rather, Matsuo discloses the injecting (inlet) port 14 on a counter substrate 10. Therefore, it is respectfully submitted that there has been an insufficient showing that one of skill in the art would have been motivated to combine and/or modify Matsuo and Niki to provide the inlet port to the sealing member in Matsuo. Furthermore, the above discussed article to Ikezaki is believed to further support the patentability of these claims over the combination of Matsuo and Niki. Reconsideration is requested.

Should the Examiner believe that anything further would be desirable to place this application in better condition for allowance, the Examiner is invited to contact Applicant's undersigned attorney at the telephone number listed below.

Respectfully submitted,



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